#24/ Supp Appeal Brief 7/22/02 VS

MICRON.003C1 PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant	:	Fazan et al.	Group Art Unit 2823
Appl. No.	:	08/037,945	
Filed	:	March 10, 1998	
For	:	STREAMLINED FIELD ISOLATION PROCESS	
Examiner	:	George R. Fourson III	

I hereby certify that this correspondence and all marked attachments are being deposited with the United States Postal Service as first-class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231, on

June 20, 2002
(Date)

Adeel S. Akhtar, Reg. No. 41,394

ON APPEAL TO THE BOARD OF PATENT APPEALS AND INTERFERENCES
SUPPLEMENTAL APPEAL BRIEF

Box AF
Assistant Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

In response to the Office Action mailed on February 20, 2002, Appellants request reinstatement of the Appeal, filed by Notice of Appeal on February 21, 2001. This Supplemental Appeal Brief incorporates and supplements the Appeal Brief ("Appellants' Brief") filed on March 21, 2001.

I. REQUEST FOR REINSTATEMENT

Appellants respectfully request reinstatement of the appeal filed by Notice of Appeal on February 21, 2001, under 37 C.F.R. § 1.193(b)(2).

II. SUPPLEMENTAL ISSUES BEFORE THE BOARD

Appellants submit that there are no new issues raised by the Office Action of February 20, 2002. Rather, the Examiner has merely withdrawn rejection of Claim 4 under 35 U.S.C. § 103 over

Germany '885 alone, and replaced it with a rejection over Germany '885 in view of Marshall et al. At the same time, the Examiner has withdrawn the provisional rejection of Claims 1 and 4 for obviousness-type double patenting and has withdrawn the Examiner's prior reliance on Miyoshi et al.

However, the essence of the Examiner's rejections remains the same. Each of the rejections relies on the Examiner's modification of German Patent No. 26885 (Germany '885) to omit an initial wet oxidation stage that is expressly taught by the Germany '885.

Accordingly, the arguments set forth in Appellant's brief, mailed March 21, 2001, remain applicable.

III. APPELLANTS' ARGUMENT

As noted above, each of the Examiner's rejections depend upon a modification of Germany '885, whereby the Examiner asserts that it would have been obvious for the skilled artisan to omit the wet oxidation step taught by Germany '885. In particular, the Examiner states the following:

> It would have been within the scope of one of ordinary skill in the art to omit the first stage oxidation with the expectation that the concomitant disclosed advantages of such a step would not be obtained because, in view of the above pointed to disclosure, the process ***could*** be performed without the first stage oxidation, although taking longer.... Note also that the reference indicates that Kooi ribbon, or nitride formed during the first stage employed, is eliminated in the second stage.

February 20, 2002 Office Action at pp. 3-4 (emphasis added).

Additionally, in a Response to Argument section, the Examiner states that "the reference suggests elimination of the step in disclosing the function of the step ***in the event*** that the disclosed function is not desired to be obtained." Office Action at p. 4 (emphasis added).

This begs the question. In essence, the Examiner states that no more than that the recited invention ***could*** be performed ***if*** desired. However, it is the very desirability that the Examiner has not shown, and it is that very desirability that the Examiner must show in order to provide a legally sound suggestion to modify. "The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification." *In re* Gordon, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984). The Examiner has not shown any statement from the prior art suggesting the ***desirability*** of omitting the wet oxidation step. By giving only a ***dis***advantage to omitting the wet oxidation, the Examiner has not provided the requisite suggestion from the prior art. Rather, the Examiner ***assumes*** some

desirability to omitting the wet oxidation. Otherwise, the skilled artisan would clearly not have omitted the wet oxidation step, knowing only of disadvantages to doing so.

Applicants have taught, in the present application, that, in the first place, omission of wet oxidation and use of only dry oxidation would avoid the Kooi effect. Moreover, Applicants have additionally taught that it would be desirable, in the context of field oxidation, to omit that effect, so much so that it would be worth the loss in speed from omission of wet oxidation.

The Examiner's reference to Germany '885 noting that the nitride formed during the first stage is "eliminated" in the second stage does not provide this teaching. Rather, the "elimination" of a previously-formed nitride inclusion results from the use of HCl and/or chlorocarbon gas during the second stage of processing. It is these additional chemicals, and not the omission of wet oxide, that eliminates the Kooi effect, in the process taught by Germany '885.

Accordingly, Appellants maintain that the Examiner has not provided a sufficient suggestion from the prior art to combine the references, and has rather engaged in an inadvertent application of hindsight in view of Appellants' own invention.

IV. CONCLUSIONS

To summarize, Appellants submit that the Examiner has failed to provide any teaching, suggestion or motivation from the prior art to combine the asserted references. While the Examiner has provided references teaching a wet oxidation followed by a dry oxidation, the Examiner has in essence asserted no more than that the prior art ***could*** have been modified to omit the wet oxidation and arrive at the claimed invention, with the understanding that the process would simply take longer. The Examiner has not provided any indication from the prior art that it would have been ***desirable*** to omit the wet oxidation, such as to make up for the loss in time. Accordingly, there is no motivation to combine the references absent impermissible hindsight.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: June 20, 2002

By: _____

Adeel S. Akhtar
Registration No. 41,394
Attorney of Record
620 Newport Center Drive, Sixteenth Floor
Newport Beach, CA 92660
(415) 954-4114

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